

REMARKS/ARGUMENTS

1. Original Claims 1 – 8 have been canceled from the application.

2. New claims 9 and 10 have been added to overcome the Examiner's rejections and to more particularly point out and distinctly claim the subject matter Applicant regards as his invention.

3. The Examiner rejected original claims 1 – 4 under 35 U.S.C. 112, second paragraph, as being indefinite, and claims 1 – 3 and 5 – 7 under 35 U.S.C. 103 (a) as being unpatentable with respect to the Ashline (5,925,007), McInnerny (2,763,264), and Landy (5,725,189) references in combination.

4. The McInnerny reference (2,763,264) discloses a device useful for giving intravenous injections in a patient's arms or legs. The device includes a rigid plate member 1, a layer of cushioning material 2 preferably composed of sponge rubber, and a cover 3 for enclosing the plate member 1 and the cushioning material 2. The plate member 1 is a lightweight metal such as an aluminum steel alloy. One pair of straps 4 attaches the device to the patient's arm with one strap 4 extending about the elbow region and one strap 4 extending about the wrist (see figure 1). The device is exclusively for restraining and immobilizing the patient's appendage – either arm or leg. (see page 1, lines 51-58 and page 3, lines 47-54).

5. The Landy reference (5,725,189) a media mounting device for motor vehicles. The device includes two wedge-shaped portions 160 and 170 that can be used separately or interfitted to support a computer monitor. At least one of the portions 160 or 170 includes straps 120 that can be wrapped around the computer monitor 110 for holding it in place. The inner portion 200 of the wedge-shaped portions 160 and 170 is composed

foam or plastic-like material to support the computer monitor thereon (see page 3, 60 – 67). Thus, it goes without saying that the wedge-shaped portions 160 and 170 must be of an unyielding, non-pliable material for supporting the computer monitor 110 with stability between, for example, the automotive vehicle seats as shown in figure 3. Since the device supports inanimate objects, comfort is not a consideration; however, stability is crucial.

6. The Ashline reference (5,925,007) discloses a carpal cuff that includes a layered structure in the form of a central platform 12, a cap 16, and an arm pad 38 all coequal in length. The user's forearm and wrist are disposed upon the arm pad 38, and arm straps 44 are used to secure the carpal cuff to the user's arm. Mounted to the underside of the platform 12 is a pair of transversely extending plates 14 and 15 that have bearing surfaces 56 to facilitate the movement of the cuff along a work surface.

7. It should be noted that the ability to combine references does not make the combination or modification obvious, i.e., the mere fact that references may be modified or combined does not make the modification or combination obvious unless the prior art suggests the desirability of the modification or combination. In re Fritch F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). Moreover, there is no motivation to modify a prior art device if the modification would render the device inoperable for its intended purpose. McGinley v. Franklin Sports, Inc. 262 F.3d 1339, 1354, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001).

8. McInnery teaches a device to immobilize and restrain a patient's arm or leg during intravenous injections. Nowhere does McInnery teach, suggest or disclose that his device is for facilitating the movement of the arm, wrist and hand over or upon a work

surface. Indeed, McInnery's patent issued in 1952 – a generation and a half before the widespread use of personal computers. On the other hand, Ashline discloses a carpal cuff that includes bearings that facilitate the movement of the carpal cuff upon a work surface.

The use of Ashline's device is categorically different and opposed to that of the

5 McInnery device – one is to immobilize movement and the other to facilitate movement.

The Examiner then makes the broad and unsubstantiated assertion that it would have been obvious to modify Ashline to include the covering 3 of McInnery. If the covering

3 of McInnery was added to the Ashline carpal cuff, then an inoperable device would

result as McInnery's covering 3 would cover the spreader plates 14 and 15 and the

10 bearing surfaces 56 – yet Ashline clearly teaches that the bearing surfaces 56 must be

uncovered for how else will the bearing surfaces 56 contact the work surface but by being

uncovered.

Applicant thus argues that combining the covering 3 of McInnery with Ashline carpal cuff is an improper combination that is not suggested by the references, and would

15 in fact render the Ashline device inoperable for its intended purpose – that is to move along a work surface while staying in continuous contact with the work surface.

9. Furthermore, the Examiner argues that it would have been obvious to include the specific dimensions of Applicant's device in the cited references; especially in the

Ashline carpal cuff. First, that is a bald assertion as there is nothing in the cited

20 references regarding dimensions – especially the critical dimension of the distance that

the wrist must be elevated above the work surface. In fact, Ashline's carpal cuff is

directed more to supporting and stiffening the forearm than properly supporting the wrist

the appropriate distance above the work surface. In contradistinction, Applicant clearly

sets forth on pages 4 and 7 of Applicant's specification, and recites in new claims 9 and 10, the precise reasons for choosing and reciting the dimensions of Applicant's device – the dimensions were not chosen willy-nilly but in accord with well-known anatomical and ergonomic considerations.

5 10. Thus, in view of the above arguments, Applicant asserts that the combination of references cited by the Examiner is an improper combination as the combination is not suggested or taught by the references themselves, and that combining the references as the Examiner speculates would, in fact, produce an inoperable device, especially so if McInnery's covering 3 is combined with Ashline's entire carpal cuff device. Moreover,
10 new claims 9 and 10 are patentably distinguishable over the cited references, taken singly or in combination.

11. New claims 9 and 10 recite, in part, specific dimensions for the wrist resting pad that result in the elevation of the individual's wrist above the work surface for the alleviation of strain and fatigue on the carpal tunnel and to the individual's wrist, hand
15 and arm; and the ability of the individual to move his or her wrist, hand and arm with the wrist rest pad remaining attached to the individual's wrist. These features are not taught, suggested or disclosed by the cited references.

12. 12. In view of the above, Applicant respectfully requests allowance of new claims 9 and 10 and passage of the case to full issuance. In addition, no new subject matter has
20 been added, and this amendment has been prepared and submitted in a good faith effort to meet the Examiner's objections as stated in the above-identified Office action.

Respectfully submitted,

